REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Claims 40-77 are now pending in this application. Claims 40-46, 49-54, and 57-58 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent 6,084,585 (Kraft). Claims 47 and 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft and further in view of U.S. Patent 6,507,854 (Dunsmoir). Claims 48 and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft and further in view of U.S. Patent 6,212,552 (Biliris). Claims 59-63, 65-72, and 74-77 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft and further in view of Dunsmoir. Claims 64 and 73 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft and Dunsmoir and further in view of Biliris. Applicants reserve the right to swear behind Kraft, Dunsmoir, and Biliris. Applicants respectfully traverse these rejections.

I.   **Rejection of Claims 40-46, 49-54, and 57-58 Under 35 U.S.C. § 102(a)**

In the Office Action, claims 40-46, 49-54, and 57-58 were rejected under 35 U.S.C. § 102(a) as being anticipated by Kraft. Applicants respectfully traverse this rejection.

Claim 40 recites:

> designing a template for a custom document that includes a
> changeable field, wherein the changeable field includes a name and
> further wherein designing the template comprises defining the
> changeable field;

Claim 50 recites:

> receive a changeable field within a template for a custom
> document, wherein the changeable field is defined by a user that
> designed the template and further wherein the changeable field
> comprises a name and a plurality of data items linked to the
> changeable field;

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Claim 58 recites:

> receive a changeable field within a template for a custom document, wherein the changeable field is defined by a user that designed the template and further wherein the changeable field comprises a name and a plurality of data items linked to the changeable field;

On pages 2-3 of the Office Action dated 10/18/2005, the Examiner states:

> Regarding independent claim 40, Kraft discloses:
>
> - designing a template for a custom document that includes a changeable field, wherein the changeable field includes a name and further wherein designing the template comprises defining the changeable field (col 8, lines 1-20, 43-67, and col 9, lines 7-18: the template with the predefined menu for entering data values to the defined fields with the field name where the template has the features of adding extra fields to be associated with a single menu field in the template and enlarging the existing data field shows that the template is designed with the template fields which are defined changeable for a custom document)

On page 5 of the Office Action dated 10/18/2005, the Examiner further states:

> Claims 50-54, 57 are for a computer program product of method claims 40-46, 49, respectively, and are rejected under the same rationale.
>
> Claim 58 is for a system of method claim 40, and is rejected under the same rationale.

Applicants disagree.

Kraft discloses "a graphical user interface (GUI) to assist a user in completing electronic forms." (Abstract). The GUI presents the user with a predetermined list of fields with which the user can populate the electronic form. Specifically, the "user <u>selects a desired menu entry from a list of available menu entries</u>, and then enters the appropriate data within the data field corresponding to the menu entry selected." (Col. 1, line 66 – Col. 2, line 2; emphasis added).

Thus, Kraft discloses an application that allows a user to create a page by entering data into predefined fields of a template. However, this is not what Applicants are claiming. Applicants claim "designing a template…wherein designing the template comprises defining the changeable field." (Claim 40; emphasis added). No embodiment of Kraft discloses designing a template by allowing the user to define the fields. Selecting a menu entry from a "list of available menu entries" (Col. 1, line 67 – Col. 2, line 1) does not allow the user to define the field, it only allows the user to select the field from a predetermined list of fields. Because at least the limitation of designing a template by defining the changeable fields is not disclosed in Kraft, Applicants respectfully submit that Kraft does not anticipate Applicants' claimed invention.

Neither the Dunsmoir reference nor the Biliris reference cited by the Examiner support this limitation. Dunsmoir describes "an enhanced caching and mirroring router which modifies stored web pages in order to indicate the age, time of capture." (Abstract). In describing the router, Dunsmoir states "the caching engine (11) uses the Boson servlet (23) to merge a marking template (25) with the cached page copy (24). Table 1 shows an example of an HTML template which could be used as the marking template." (Col. 4, lines 29-33). Dunsmoir further describes "Boson is passed this template …, and it is passed the parameter string (25) …. Then, it merges the two to create a new HTML output (26) as shown in Table 3." (Col. 4, lines 67-71). Thus, Dunsmoir describes use of a template in creating a modified HTML file (*See* Dunsmoir, Table 3) and does not describe designing the template or defining the fields in the template at all. As a result, similar to the Kraft reference, Dunsmoir relates to a system of populating predefined fields of a template. More specifically, Dunsmoir discloses a method for merging timing information into a web page such that an end viewer can determine when the web page was retrieved. Merging data into predefined fields of a template does not constitute defining the field because the fields cannot be defined or altered by a user.

Biliris describes "a messaging system …, which supports combinations of directory and mailing list addressing mechanisms." (Abstract). Examiner cites Biliris as disclosing creation of a mailing list. Biliris, however, fails to teach, suggest, or describe anything to do with a

template. Thus, none of Kraft, Dunsmoir, or Biliris describe, suggest, or teach "designing a template for a custom document that includes a changeable field, wherein the changeable field includes a name and further wherein designing the template comprises defining the changeable field" as recited in claim 40 or "receive a changeable field within a template for a custom document, wherein the changeable field is defined by a user that designed the template and further wherein the changeable field comprises a name and a plurality of data items linked to the changeable field" as recited in claims 50 and 58. An anticipation rejection cannot properly be maintained where the references used in the rejection do not disclose all of the recited claim elements. Therefore, Applicants respectfully request withdrawal of the rejection of claims 40, 50, and 58. Applicants respectfully traverse any arguments posed by Examiner relative to claims 41-46, 49, 51-54, and 57 as they are allowable for at least the reasons outlined above relative to claims 40, 50, and 58. Therefore, Applicants respectfully request withdrawal of the rejection of claims 40-46, 49-54, and 57-58.

II. Rejection of Claims 47 and 55 Under 35 U.S.C. § 103(a)

In the Office Action, claims 47 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft and further in view of Dunsmoir. Applicants respectfully traverse this rejection because the Examiner has failed to present a prima facie case of obviousness. MPEP § 2143 states:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

At a minimum, the Examiner has failed to demonstrate that Kraft and Dunsmoir in combination disclose, teach, or suggest all of the claim limitations as recited in Claims 47 and 55.

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As discussed in Section I. above, Kraft and Dunsmoir fail to teach the limitation "designing a template for a custom document that includes a changeable field, wherein the changeable field includes a name and further wherein designing the template comprises defining the changeable field" as recited in claim 40 and the limitation "receive a changeable field within a template for a custom document, wherein the changeable field is defined by a user that designed the template and further wherein the changeable field comprises a name and a plurality of data items linked to the changeable field" as recited in claim 50. As a result, neither Kraft nor Dunsmoir disclose, suggest, or teach all of the limitations of claims 47 and 55. Therefore, Applicants respectfully request withdrawal of the rejection of claims 47 and 55 which depend from claims 40 and 50, respectively.

III. Rejection of Claims 48 and 56 Under 35 U.S.C. § 103(a)

In the Office Action, claims 48 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft and further in view of Biliris. Applicants respectfully traverse this rejection because the Examiner has failed to present a prima facie case of obviousness. At a minimum, the Examiner has failed to demonstrate that Kraft and Biliris in combination disclose, teach, or suggest all of the claim limitations as recited in Claims 48 and 56.

As discussed in Section I. above, Kraft and Biliris fail to teach the limitation "designing a template for a custom document that includes a changeable field, wherein the changeable field includes a name and further wherein designing the template comprises defining the changeable field" as recited in claim 40 and the limitation "receive a changeable field within a template for a custom document, wherein the changeable field is defined by a user that designed the template and further wherein the changeable field comprises a name and a plurality of data items linked to the changeable field" as recited in claim 50.

Additionally, Examiner cites Biliris as disclosing creation of a mailing list. Specifically, on pages 7-8 of the Office Action dated 10/18/2005, the Examiner states:

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Regarding claim 48, ..., Kraft does not disclose creating a mailing list ....

Billiris discloses creating a mailing list, wherein the mailing list comprises a plurality of identities of message recipients (col 1, lines 40-64). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Billiris and combined Billiris into Kraft for linking the mailing list to the changeable field of the template and populating the changeable field of the template with a record from the mailing list to generate a different document for each record for the following reason. The mailing list including identities of message recipients in Billiris is a list of records of recipients as the plurality of data in Kraft. Replacing the plurality of data linking to the changeable field in Kraft with the plurality of records of recipients in the mailing list linking to the changeable field and populating such records to the changeable filed would provide different types of data to be used in populating the fields in the form.

Claim 56 is for a computer program product of method claim 48, and is rejected under the same rationale.

Biliris describes that the "user specifies the recipients of the message by entering specifications for a declarative address into declarative address input and generation block 104." (Biliris, Col. 4, lines 56-59). Biliris further describes:

query evaluation block 116 of backend database system 114 receives the query or set of queries, accesses database 118 to retrieve the information requested by the queries and transmits the retrieved information to address resolution module 110. Address resolution module 110 then, transmits the resolved addresses to messaging server 106.

(Biliris, Col. 5, lines 15-21). Biliris, however, fails to describe, suggest, or teach "wherein the mailing list comprises a plurality of records to link to the changeable field of the template, and successively populating the changeable field of the template with a record from the mailing list thereby generating a different document for each record." As a result, neither Kraft nor Biliris disclose, suggest, or teach all of the limitations of claims 48 and 56. Therefore, Applicants

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respectfully request withdrawal of the rejection of claims 48 and 56 which depend from claims 40 and 50, respectively.

IV.   Rejection of Claims 59-63, 65-72, and 74-77 Under 35 U.S.C. § 103(a)

In the Office Action, claims 59-63, 65-72, and 74-77 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft and further in view of Dunsmoir. Applicants respectfully traverse this rejection because the Examiner has failed to present a prima facie case of obviousness. At a minimum, the Examiner has failed to demonstrate that Kraft and Dunsmoir in combination disclose, teach, or suggest all of the claim limitations as recited in claims 59-63, 65-72, and 74-77.

Claim 59 recites:

> editing the template using the application, the application executing at the server;

Claim 68 recites:

> provide editing of the template using the application, the application executing at a server;

Claim 77 recites:

> provide editing of the template using the application, the application executing at the server computer;

On pages 8-9 of the Office Action dated 10/18/2005, the Examiner states:

> Regarding independent claim 59, ... Kraft does not disclose:
>
> - editing the template using the application, the application executing at the server (col 5, lines 58-67) It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Dunsmoir into Kraft since Dunsmoir discloses modifying the template at the server providing the advantage to incorporate into Kraft for desirably changing the

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form structure in Kraft, which is a template, when said form is submitted to the server.

On page 11 of the Office Action dated 10/18/2005, the Examiner further states:

Claims 68-72, 74-76 are for a computer program product of method claims 59-63, 65-67, respectively, and are rejected under the same rationale.

Claim 77 is for a system of method claim 59, and is rejected under the same rationale.

Applicants disagree.

As stated in Section I., Kraft discloses "a graphical user interface (GUI) to assist a user in completing electronic forms." (Abstract). Kraft further discloses "the user accesses the menu field and selects one or more of the menu entries corresponding to the information the user wishes to enter. ... the user accesses the data field within the row entry template and enter [sic] data therein." (Kraft, Col. 5, lines 17-32). Thus, Kraft discloses an application that allows a user to create a page by entering data into predefined fields of a template. However, this is not what Applicants are claiming. Applicants claim "editing the template using the application, the application executing at the server." (Claim 59; emphasis added). No embodiment of Kraft discloses editing the row entry template.

As stated in Section I., Dunsmoir describes "an enhanced caching and mirroring router which modifies stored web pages in order to indicate the age, time of capture." (Abstract). Table 1 of Dunsmoir shows an example of an HTML template which could be used as the marking template. Dunsmoir does not describe editing the HTML template at all.

Thus, neither Kraft nor Dunsmoir teach at least the limitation "editing the template using the application, the application executing at the server." An obviousness rejection cannot properly be maintained where the references used in the rejection do not disclose all of the recited claim elements. Therefore, Applicants respectfully request withdrawal of the rejection of claims 59, 68, and 77. Applicants respectfully traverse any arguments posed by Examiner

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relative to claims 60-63, 65-67, 69-72, and 74-76 as they are allowable for at least the reasons outlined above relative to claims 59, 68, and 77. Therefore, Applicants respectfully request withdrawal of the rejection of claims 59-63, 65-72, and 74-77.

V.   Rejection of Claims 64 and 73 Under 35 U.S.C. § 103(a)

In the Office Action, claims 64 and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft and Dunsmoir and further in view of Biliris. Applicants respectfully traverse this rejection because the Examiner has failed to present a prima facie case of obviousness. At a minimum, the Examiner has failed to demonstrate that Kraft, Dunsmoir, and Biliris in combination disclose, teach, or suggest all of the claim limitations as recited in Claims 64 and 73.

As discussed in Section IV. above, Kraft and Dunsmoir fail to teach the limitation "editing the template using the application, the application executing at the server" as recited in claim 59 and the limitation "provide editing of the template using the application, the application executing at a server" as recited in claim 68. As a result, neither Kraft nor Dunsmoir disclose, suggest, or teach all of the limitations of claims 64 and 73 which depend from claims 59 and 68, respectfully.
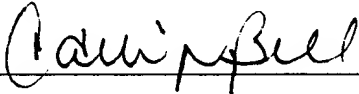
Additionally, as discussed in Section III. above, Kraft and Biliris fail to teach the limitation "wherein the mailing list comprises a plurality of records to link to the changeable field of the template, and successively populating the changeable field of the template with a record from the mailing list thereby generating a different document for each record" as recited in claims 64 and 73. Therefore, Applicants respectfully request withdrawal of the rejection of claims 64 and 73 which depend from claims 59 and 68, respectively.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2350. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2350. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2350.

Respectfully submitted,

Date December 16, 2005   By _Callie M. Bell_

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